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**UNITED STATES PATENT & TRADEMARK
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UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

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Paper No. 20

In re Application of :
Michael C Scroggie et al. :
Application No. 09/401,939 :
Filed: September 23, 1999 :
For: SYSTEM AND METHOD FOR :
PROVIDING SHOPPING AIDS :
AND INCENTIVES TO :
CUSTOMERS THROUGH A :
COMPUTER NETWORK :

DECISION ON PETITION UNDER
37 C.F.R. 1.181 TO REMOVE
FINAL STATUS

This is a decision on the petition under 37 CFR 1.181 filed March 14, 2002 (Paper No. 18) for removal of the final status (Final rejection), made FINAL in Paper No. 13 (mail date November 22, 2002).

CASE HISTORY

This application was filed on September 23, 1999, with originally presented claims 1-31. The Preliminary Amendment, filed concurrently with the application, cancelled claims 1-31 and presented claims 32-70.

The Examiner issued a first, non-final rejection in an Office action mailed to Applicant on July 29, 2002 (Paper No. 6). This action included a rejection of the pending claims under 35 USC 103(a) as being unpatentable over "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike)" and included a rejection taking Official Notice of certain facts that were in the Examiner's knowledge "since at least 1994."

In Paper No. 12, filed October 23, 2002, Applicant filed a response amending claims 32-34, 37-43, 58-60, and 63-69. Applicant included argument that "[T]he examiner did not provide a declaration of his personal knowledge of the PerformanceBike.com web

site, pursuant to MPEP 2144.03 and 37 CFR 1.104(d)(2). Therefore, the examiner's non-declaration factual assertions are not probative. ... if the examiner does provide a declaration and maintains these rejections, I will request that Mr. Ruggeri [the web master of PerformanceBike.com] provide a corresponding declaration."

In Paper No. 13, mailed November 22, 2002, the Examiner issued a Final rejection and provided an "Affidavit Supporting Obviousness Rejection" which substantially repeats the statements that were made in relation to Official Notice in the first, non-final office action.

RELIEF REQUESTED

The petition under 37 CFR § 1.181 states that "[T]he final status of the rejection is improper because the examiner's declaration is new evidence in support of his personal knowledge based prior art rejections and therefore final status is improper. Accordingly, the evidence submitted in conjunction with the appeal brief should be entered and considered in the appeal."

REGULATIONS AND PRACTICE

37 C.F.R. § 1.181 states in part:

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner.

MPEP § 2144.03(C) states in part:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

MPEP § 2144.03(D) states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. See MPEP § 706.07(a).

37 CFR 1.192(a) states in part:

Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

and MPEP 1206(8) (referring to this sentence) states:

This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider should be included in the brief. It should be noted that arguments not presented in the brief and made for the first time at the oral hearing are not normally entitled to consideration. In re Chiddix, 209 USPQ 78 (Comm'r Pat. 1980); Rosenblum v. Hiroshima, 220 USPQ 383 (Comm'r Pat. 1983).

OPINION

There are, in effect, two separate issues raised above in the statement of relief requested, (1) applicant is attempting to get the evidence submitted in conjunction with the appeal brief entered, and (2) applicant is attempting to get the finality of the rejection withdrawn in order to get this evidence entered at appeal.

With regard to issue (1), the petition is premature because the Examiner has not yet refused to enter and consider the information. Therefore the petition is **DISMISSED** in this regard as being premature.

With regard to issue (2), the requirements of MPEP 2144.03 state that "[I]f applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained." In regard to the evidence necessary after adequate traversal, "[I]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." In regard to making the next action Final, [I]f the examiner adds a reference in the next Office action after applicant's

rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final."

The Examiner's Final rejection including the Affidavit is correct and consistent with Office policy and practice. Accordingly, the Petition is **DENIED**.

If the petitioner desires further review of the Director's Decision, applicant should consider filing a Petition for Review of the Director's Decision under 37 CFR §1.181(a)(3).

Summary: *Petition Denied*



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